

REMARKS

The present Amendment is in response to the Final Office Action mailed January 22, 2008. Claims 1-2, 5-8, 10-12, and 15-20 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,152,937 (*Peterson*), claims 3-4 and 13-14 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Peterson* in view of U.S. Patent 6,036,720 (*Abrams*), while claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Peterson* in view of U.S. Patent 5,769,870 (*Salahieh*).¹ Claims 1, 10, and 15 have been amended.² Thus, Claims 1-20 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

PRIOR ART REJECTIONS

Rejection Under 35 U.S.C. §102(b)

The Office Action rejected claims 1-2, 5-8, 10-12, and 15-20 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,152,937 (*Peterson*). Because *Peterson* does not disclose,

¹ Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should the need arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art. Further, notwithstanding the arguments made herein, it should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise.

² Support for the claim amendments can be found throughout the specification.

teach, or suggest each and every element of the rejected claims, Applicant respectfully traverses this rejection in view of the following remarks.

The Office Action asserts that “Peterson et al. disclose[s] a method of manufacture of a clip-like device comprising the steps of . . . heat-treating the clip” (Office Action, page 2). In support of this assertion, the Office Action cited the following portion of *Peterson* “The machined tube is placed 40 in a mold and heat-shaped into a geometry approximately that which the component 10 will assume after deployment” (*Peterson*, col. 6, ll. 39-41). The “geometry” after deployment has a configuration to “join a graft conduit and a tubular body conduit in an end-to-end anastomosis”, which can be seen in FIG. 14 (*Id.* at col. 7, l. 66 - col. 8, l. 1). However, in direct contrast with this cited portion, claims 1 and 10 recite, in part, “heat treating the clip with the clip in a planar configuration. ” Applicant respectfully submits that heat treating a machined tube into the geometry shown in FIG. 14 is not the same as “heat treating the clip with the clip in a planar configuration”, as recited, in part, by claims 1 and 10.

Furthermore, the Office Action asserts that “Peterson et al. also disclose the step of heat treating the device into a shape” and that “[t]he shape may be of a desired positioning of the projections (16/18)” (Office Action, page 2). Applicant respectfully submits that claim 1 does not recite “heat treating the device into a shape . . . of a desired positioning of the projections.” Rather, claims 1 and 10 recite, in part, “heat treating the clip with . . . the plurality of tines extending within the plane of the clip to program the clip and the plurality of tines to be biased to remain within the plane in the planar configuration.”

The Office Action has not cited, nor can Applicant find, any portion of *Peterson*, that discloses, teaches, or suggests this limitation. Rather, *Peterson* discloses that, prior to “heat-shaping” the tube, “[t]he next step is to deflect fingers on the machined tube to approximately the positions that are desired in the finished and installed connector. For example, FIG. 3 shows resilient fingers 20 and 18 extending radially and axially outward from an end portion of band 11” (*Peterson*, col. 6, ll. 35-39). Applicant respectfully submits that “deflect[ing] fingers on the machined tube” to “extend[] radially and axially outward” from the tube is not the same as “heat treating the clip with . . . the plurality of tines extending within the plane of the clip”, as recited in part in claims 1 and 10.

Therefore, because *Peterson* does not disclose, teach, or suggest "heat treating the clip with the clip in a planar configuration and the plurality of tines extending within the plane of the clip", as recited, in part, by claims 1 and 10, Applicant respectfully requests the withdrawal of the rejection of claims 1-2, 5-8, and 10-12 under Section 102. Claim 15 recites, in part, "heat treating the clip with the clip in a planar configuration and the pair of primary tines extending within the plane of the clip to program the clip and the pair of primary tines to be biased to remain within the plane in the planar configuration." For reasons similar to those recited above, Applicant respectfully requests the withdrawal of the rejection of claims 15-20 under Section 102.

Rejection Under 35 U.S.C. § 103

The Office Action rejected claims 3-4 and 13-14 under 35 U.S.C. § 103(a) as being unpatentable over *Peterson* in view of U.S. Patent No. 6,036,720 (*Abrams*) and claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Peterson* in view of U.S. Patent No. 5,769,870 (*Salahieh*).

Applicant traverses the Examiner's rejection for obviousness because the references – either individually or in combination – fail to teach or suggest each and every element of the rejected claims. As shown above, *Peterson* does not disclose, teach, or suggest "heat treating the clip with the clip in a planar configuration and the plurality of tines extending within the plane of the clip" as recited, in part, by claims 1 and 10.

The Office Action has not cited, nor can Applicant find, any portion of *Abrams* that teaches or suggests these limitations. Furthermore, the Office Action has not cited, nor can Applicant find, any portion of *Salahieh* that teaches or suggests these limitations. Thus, Applicant respectfully submits that the Office Action has not provided a *prima facie* case of obviousness over claims 3-4, 9, and 13-14. Consequently, Applicant requests the withdrawal of the rejection of claims 3-4, 9, and 13-14 under Section 103.

Application No. 10/616,832
Amendment "C" dated June 23, 2008
Reply to Office Action mailed January 22, 2008

CONCLUSION

In view of the foregoing, Applicant believes the claims as amended are in allowable form. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorney.

Dated this 23rd day of June, 2008.

Respectfully submitted,

/Paul N. Taylor, Reg.# 57271/

PAUL N. TAYLOR
Attorney for Applicant
Registration No. 57,271
Customer No. 057360
Telephone (801) 533-9800

1725434_1